

REMARKS

Claims 1-5 and 7-10 are pending. No new matter has been added by way of the present amendment. For instance, Claim 1 has simply been amended to include the subject matter from claim 11, now canceled. Thus, no new matter has been added.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 USC § 103(a)

The Examiner has rejected claims 1-5 under 35 U.S.C. § 103(a) as being obvious over Ueda et al. (JP 2002-283313, using English translation) in view of Stover '582, Kawai '414, and Fuji et al., (GB 20134737).

Applicants respectfully traverse this rejection and submit that the subject matter of claim 11 has been incorporated into claim 1, since the Examiner has not rejected the combined subject matter of claim 1 and claim 11 over the above references, this rejection is moot. Reconsideration and withdrawal of this rejection is respectfully requested.

The Examiner has also rejected claim 7 under 35 USC § 103(a) as being obvious over Ueda et al. (JP Publication No. 2002-283313), Stover '582, Kawai et al. '414, Fuji et al. (newly cited GB 20134737) and Simonson et al. '511.

Further, the Examiner has rejected claim 8 under 35 USC § 103(a) as being obvious over Ueda et al., Stover '582, Kawai et al. '414, Fuji et al. '737 and Seale et al.

REMARKS

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Applicants respectfully traverse this rejection and submit that the subject matter of claim 11 has been incorporated into claim 1. Since the Examiner has not rejected the combined subject matter of claim 1 and claim 11 over the above references, this rejection is moot. Reconsideration and withdrawal of this rejection are respectfully requested.

The Examiner has also rejected claim 7 under 35 USC § 103(a) as being obvious over Ueda et al. (JP Publication No. 2002-283313), Stover '582, Kawai et al. '414, Fuji et al. (newly cited GB 20134737) and Simonson et al. '511.

Further, the Examiner has rejected claim 8 under 35 USC § 103(a) as being obvious over Ueda et al., Stover '582, Kawai et al. '414, Fuji et al. '737 and Seale et al.

Additionally, the Examiner has rejected claim 8 under 35 USC § 103(a) as being obvious over Ueda et al., Stover '582, Kawai et al. '414, Fuji et al. '737, Seale et al. and Onishi et al. (JP Publication No. 2000-263519).

Applicants respectfully traverse each of the above rejections with respect to claims 7-10. The Examiner has not rejected the subject matter of claims 1 and 11 based upon the above references. Thus, the above rejections with respect to claims 7-10 are moot. Reconsideration and withdrawal thereof are respectfully requested.

Lastly, the Examiner has rejected claim 11 under 35 USC § 103(a) as being obvious over the combined disclosures of Ueda et al., Stover '582, Kawai et al. '414, Fuji et al. '737 and Betzner et al. '436. Applicants respectfully traverse this rejection.

Applicants respectfully submit that none of the references of Ueda et al., Stover '582, Kawai et al. '414, Fuji et al. '737 and Betzner et al. '436 suggest or disclose utilizing a phenolic resin comprising 10-40 percent by weight of monomer and 60-90 percent by weight of polymer having an average molecular weight of 200 – 2,000.

However, independent claim 1 has been amended to recite the specific subject matter referenced above. The Examiner has attempted to rely upon Betzner '436 as disclosing an adhesive used to impregnate fibers for the purpose of creating a fiberboard wherein the adhesive agent has a molecular weight of 300 - 2,000 for all possible polymer/monomer weight percent combinations. However, the specific phenolic resin recited in the present claims is neither suggested nor disclosed by Betzner '436. As such, Applicants respectfully submit that the Examiner has failed to present a valid *prima facie* case of obviousness.

Further, the disclosure of Betzner '436, having such a generic nature, cannot suggest to one of skill in the art the specifically claimed subject matter of presently pending claim 1.

Applicants remind the Examiner that the fact that a claimed product is within the broad field of the prior art and one might arrive at it by selecting specific items and conditions does not render the product obvious in the absence of some directions or reasons for making such selection. Ex parte Kuhn, 132 USPQ 359 (POBA 1961). Similarly, a compound within the scope of a generic formula which encompasses more than 100 million compounds cannot render a product obvious absent some direction or reasons for selecting the substituents required to arrive at the compound. In re Baird, 29 USPQ2d 1550, 16 F.2d 380 (Fed. Cir. 1994).

As such, the Examiner has failed to present a valid *prima facie* case of obviousness.

Additionally, even if the Examiner has hypothetically established a valid *prima facie* case of obviousness, a point not conceded by Applicants, the primary reference of Ueda fails to suggest or disclose the superior properties achieved by the present invention. For example, by utilizing the specific phenolic resin as recited in independent claim 1, a board having superior properties with respect to expansion coefficient in water – absorption thickness (percentage) and peel strength (MPa) is achieved. Such properties are completely unexpected in view of the teachings of the prior art. For instance, the Examiner is requested to refer to Examples 6-9 of the present invention and the results shown in Table 2 at page 40 of the present specification.

In view of such unexpectedly superior results, any hypothetical *prima facie* case of obviousness is moot. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection and allow the currently pending claims.

In view of the above comments, Applicants respectfully submit that the present claims are in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw all rejections and permit the presently pending application to issue.

Request for Initialed Form PTO-1449

On January 15, 2004, Applicants filed an Information Disclosure Statement (IDS) with an attached PTO-1449. However, the Examiner has not yet returned an initialed copy of this form PTO-1449 indicating that the cited reference has been considered. Accordingly, Applicants request that the Examiner return an initialed copy of the form PTO-1449 which accompanied the January 15, 2004 IDS.

If the Examiner has any questions or comments please contact Craig A. McRobbie, Registration No. 42,874, at the offices of Birch, Stewart, Kolasch & Birch, LLP at the number listed below.

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Respectfully submitted,

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